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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,177	12/21/2001	Craig P. Hunter	42697.122US2	7824
23483	7590	01/14/2004	EXAMINER	
HALE AND DORR, LLP			TUNG, JOYCE	
60 STATE STREET			ART UNIT	
BOSTON, MA 02109			PAPER NUMBER	
			1637	

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/038,177

Applicant(s)

HUNTER ET AL.

Examiner

Joyce Tung

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 18 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: please see the attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 53-58 and 66-79.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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Without entering the amendment filed 11/18/2003, claims 53-58 and 67-79 are pending.

1. The newly added language "under conditions to produce one or more cDNAs longer than about 600 nucleotides" and newly added claim 80 raise new issues that would require further consideration and/or search.

2. The newly added language "under conditions to produce one or more cDNAs longer than about 600 nucleotides" and newly added claim 80 raise the issues of new matter since there is no support in the specification to support the newly added limitations.

3. Without entering the amendment filed 11/18/2003, the rejection of claims 53-56, 58 and 66-79 under 35 U.S.C. 103(a) as being unpatentable over Nycz et al. (Analytical Biochemistry, 1998, Vol. 259, pg. 226-234). The response argues that the reference does not provide motivation to produce cDNAs longer than about 100 nucleotides. However, as indicated by the reference, with the inclusion of the single-strand binding protein, the amplification efficiency increases (See pg. 226, column 1, the Abstract).

The response next argues that Nycz et al. disclose a quantitative reverse transcription strand displacement. Since the claim language contains "comprises" for performing the instant method, any steps needed to fulfill the method would have been added to the method.

The response further argues that Nycz et al. do not suggest addition of single strand binding protein to a reverse transcription process to enhance the processivity of the reverse transcriptase to produce cDNAs longer than 600 nucleotides. These limitations were not entered. Thus, the teachings of Nycz et al. read on the limitations of the claims and the rejection is maintained.

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4. The rejection of claim 57 under 35 U.S.C. 103(a) as being unpatentable over Nycz et al. (Analytical Biochemistry, 1998, Vol. 259, pg. 226-234), as applied to claims 53-56 and 58 above and further in view of Cleuziat et al. (5849,547) with the same reasons as set forth in section 3 above.

Summary

5. No claims are allowable.

6. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung JT
January 9, 2004

Jeffrey Siew
JEFFREY SIEW
PRIMARY EXAMINER
1/14/04